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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,106	08/20/2001	Wai C. Wong	45990-ZAA/JPW/ADM	7129

7590

05/01/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 05/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,106

Applicant(s)

WONG ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,10-14,21,22,24,25,27 and 28 is/are pending in the application.

4a) Of the above claim(s) 8 and 13 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3,4,7,10-12,14,21,22,24,25,27 and 28 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Applicants' response, which included amendment to claims 1, 3, 4, 22 and 25, filed on 2/19/2003, is made of record.

Claims 1, 3-4, 10-14, 21-22, 24-25, and 27-28 are pending in the application.

Claims 8 and 13 were withdrawn from consideration as noted in the previous office action.

Claims 1, 3, 4, 7, 10-12, 14, 21-22, 24-25, and 27-28 are active in the application.

In view of applicants' response, particularly amendment to claims 1, 3, 4, 22 and 25 al, all 112 rejections made in the previous office action have been obviated. Furthermore, in view of applicants' response, prior art rejection over Chapleo et al. also has been obviated.

However, the following prior art rejections remain.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 3-4, 7, 11-12, 14, 21-22 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Henry et al. US 6,162,818 for reasons of record. To repeat:

Henry et al. teaches several 2-imidazolinylaminoindole compounds useful as α_2 -adrenoreceptor agonists for treating various disorders of α_2 -adrenoreceptors, which include compounds claimed in the instant claims. See formula I on col. 3 and note the definition of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , and R^7 (note R^1 is mislabeled as R^8 but both abstract and the tables showing compounds made clearly shows R^1). Particularly note only one of R^4 , R^5 , and R^6 can be 2-imidazolinylamino group. See col. 7-12 for the process of making and col. 12 through col. 22 for examples. Especially see examples 193-250, 251-310, and 377-438 on col. 25 through 29, which includes compounds claimed in the instant claims for the same use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-4, 7, 10-12, 14, 21-22 and 24-25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al. US 6,162,818 for reasons of record. To repeat:

Teachings of Henry et al as discussed in the above 103 rejection is incorporated herein. As noted above Henry et al. teaches several 2-imidazolinylaminoindole compounds useful as α_2 -adrenoreceptor agonists for treating various disorders of α_2 -adrenoreceptors.

Instant claims differs from the reference in recites variously substituted indole ring bearing a 2-imidazolinylamino groups in addition to those compounds anticipated by the prior art. For example instant claim 28 require an ethyl group on the indole nitrogen which not shown in the examples of the prior art compounds.

However, Henry et al. teaches equivalency of the exemplified compounds with those claimed for compound of formula I in the definition of R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , and R^7 . Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds variously substituted in 5-membered nitrogen hetero ring and the aryl ring as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

These two 102/103 rejections over Henry et al. are same as made in the previous office action. Although applicants' have acknowledged Henry et al. as prior art, and indicated submission of a 131 declaration, they have not yet submitted such declaration or a proper traversal.

Hence the 102(e) and 103 rejections over Henry et al. are maintained.

References cited in the Information Disclosure Statement (paper # 2) are made of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V

V. Balasubramanian

4/28/2003

Mukund J. Shah

MUKUND J. SHAH

SUPERVISORY PATENT EXAMINER

AU 1624